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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/670,091	09/23/2003	Louis Brown Abrams	4811-9-CON	6362
22442 7590 02/20/2007 SHERIDAN ROSS PC 1560 BROADWAY SUITE 1200 DENVER, CO 80202			EXAMINER JUSKA, CHERYL ANN	
			ART UNIT 1771	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		02/20/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/670,091

Applicant(s)

ABRAMS, LOUIS BROWN

Examiner

Cheryl Juska

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 February 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10, 12-14 and 42-53 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10, 12-14 and 42-53 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>02/02/07</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Applicant's Amendment After Final filed February 2, 2007, has been entered. The specification and claims 1 and 43 have been amended as requested. Claims 11 and 15-41 are cancelled. Thus, the pending claims are 1-10, 12-14, and 42-53.
2. The cancellation of claim 11 renders moot the 112, 2nd rejection set forth in section 8 of the Final Rejection (11/02/06). Said amendment is sufficient to withdraw the 112, 1st rejection set forth in section 10 of said Final Rejection. Additionally, the amendment to the specification would be sufficient to overcome the objection to the drawings set forth in section 4 of the Final Rejection. Furthermore, the cancellation of claim 41 would render moot the claim objection set forth in section 6 of the Final Rejection.
3. Despite these advances, the application is not in condition for allowance for the reasons set forth below.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
5. Claims 1-10, 12-14, and 42-45 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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6. Claim 1 is indefinite for the use of the phrase “substantially all free ends of the flock contact the thermosetting film.” It is unclear how the ends of the flock that contact the thermosetting film can be considered the “*free* ends of the flock.” The phrase “free ends of the flock” is only relevant when describing the method of forming a flock transfer according to the invention. Note the language of claim 3, wherein the flock ends are described as “first ends” and “opposing second ends.” Claim 44 is similarly rejected. Claims 2-10, 12-14, and 42 are also rejected for their dependency upon claim 1.

7. Claims 4 and 5 are indefinite because if the product recited in claim 1 is not adhered to a substrate, any claim dependent therefrom which adheres said product to a substrate is inconsistent with the parent claim. For the purposes of examination, the claims are interpreted as being adhered to a substrate.

8. Claim 45 recites the limitation “the carrier sheet” in line 3 of the claim. There is insufficient antecedent basis for this limitation in the claim.

9. Claims 1 and 43 are indefinite for it is unclear if the phrase “wherein the flock is in contact with and adhered to the thermosetting film” excludes an intermediate adhesive layer between said flock and film. The claims have been previously examined as if said intermediate adhesive layer is excluded from said claim. However, this interpretation is deemed too narrow in that such an interpretation would render claims 10 and 51, which recite that “there is no binder adhesive located between the thermosetting film and the flock,” as being not further limiting. For the purposes of examination, the only claims that exclude an intermediate adhesive layer are claims 10 and 51. Additionally, note that the phrases “free of an acrylic adhesive” and “free of a hot melt adhesive” recited in claims 1, 4, 43, 46, and 47 do not necessarily exclude an

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intermediate flock adhesive layer. For example, non-acrylic adhesives or non-hot melt adhesives could still be present. Furthermore, the phrase “wherein the flock is in direct physical contact with the thermosetting film” does not necessarily exclude an intermediate adhesive layer in that flocked substrates commonly comprise flock that penetrates the flock adhesive and “physically contacts” the underlying material (i.e., thermosetting film).

10. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

11. Claim 9 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 9 limits the thermosetting film to being crosslinked. However, the specification teaches crosslinking occurs when the flock assembly is adhered to the substrate of the final product. Since claim 1, from which 9 depends, claims the flock assembly is not adhered to a substrate, claim 9 is not enabled by the specification. In other words, the specification does not enable fully crosslinking without being adhered to a substrate.

Claim Rejections - 35 USC § 102

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

13. Claims 43 and 50-53 are rejected under 35 U.S.C. 102(b) as being anticipated by US 4,418,106 issued to Landler et al.

Applicant claims a flocked assembly comprising flock and a solid thermosetting film, wherein said flock is in contact with and adhered to the thermosetting film and wherein said thermosetting film is not adhered to a substrate. Additionally, applicant claims the thermosetting film is not fully crosslinked or activated and the flock is in direct physical contact with said thermosetting film.

Landler discloses a method of making a flocked assembly and said assembly made therefrom. Specifically, Landler discloses a thermosetting plastic foam or film layer having a layer of flock thereon by applying said flock while the thermosetting layer is non-crosslinked and then partially crosslinking to bond said flock thereon (abstract). While the thermosetting layer of Landler is not self-supporting (i.e., employs a carrier sheet), the invention does not *require* being adhered to a substrate or backing (col. 2, lines 47-53 teaches backing “can” be applied). Hence, claims 43 and 50-53 are anticipated by the cited Landler reference.

14. Claims 1, 2, 6, 12-14, 42-44, 50, 52, and 53 are rejected under 35 U.S.C. 102(b) as being anticipated by US 5,338,603 issued to Mahn, Sr. et al.

Mahn discloses an ornamental heat transfer comprising an upper decorative layer and a lower thermoset layer of uncured linear saturated polyester film (abstract). The decorative upper layer may be a flock layer, wherein an intermediate adhesive layer of PVC (i.e., free of acrylic or hot melt adhesive) is employed to adhere said flock to said thermoset film (abstract and col. 4, lines 43-50). The heat transfer may be laminated to nylon substrates by applying heat and

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pressure to melt the polyester and activate the curing agent (i.e., crosslinking agent) of said polyester (col. 4, line 66-col. 17). In other words, the transfer that is not adhered to a substrate comprises a thermoset that is not fully activated or crosslinked. Therefor claims 1, 2, 6, 12-14, 42-44, 50, 52, and 53 are anticipated by the cited Mahn reference.

Claim Rejections - 35 USC § 103

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. Claims 45-49 rejected under 35 U.S.C. 103(a) as being unpatentable over the cited Landler reference in view of US 4,810,549 issued to Abrams et al.

Landler fails to teach the use of a flock transfer to apply the flock fibers onto the thermosetting layer. However, the use of said transfers having release sheets and a release agent are well known in the art for applying flock to piece work or oddly shaped articles and to apply flock in a decorative pattern. For example, note Abrams, abstract and col. 2, lines 34-43. Thus, it would have been obvious to one of ordinary skill in the art to apply said flock by means of a transfer rather than by direct flocking in order to produce a decorative pattern or shape.

Therefore, claims 45 and 46 are rejected over the cited prior art.

While the cited prior art fails to teach a polyester or polyurethane thermosetting adhesive, it would have been obvious to one of ordinary skill in the art to substitute a polyester or polyurethane thermosetting resin for the thermosetting resin of Landler since it has been held to

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be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use. *In re Leshin*, 125 USPQ 416. Therefore, claims 47 and 48 are also rejected.

Regarding claim 49, which limits the thermosetting film to being "pre-cut to correspond to a shape of the transfer," the claim is also obvious over the cited prior art. Said limitation reflects the method of making the flock transfer assembly. As such, said limitation is not necessarily given patentable weight at this time since the claims are examined on the structure of the final product claimed. It is believed that the final product of the prior art has the same structural features of the present invention. Therefore, claim 49 is also rejected.

17. Claims 3-5, 7, 8, 45-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over the cited Mahn reference in view of US 4,810,549 issued to Abrams et al.

Mahn fails to teach the use of a flock transfer to apply the flock fibers onto the thermosetting layer. However, the use of said transfers having release sheets and a release agent are well known in the art for applying flock to piece work or oddly shaped articles and to apply flock in a decorative pattern. For example, note Abrams, abstract and col. 2, lines 34-43. Thus, it would have been obvious to one of ordinary skill in the art to apply said flock by means of a transfer rather than by direct flocking in order to produce a decorative pattern or shape. Therefore, claims 3-5, 8, 45 and 46 are rejected over the cited prior art.

While the cited prior art fails to teach a polyester or polyurethane thermosetting adhesive, it would have been obvious to one of ordinary skill in the art to substitute a polyester or polyurethane thermosetting resin for the thermosetting resin of Landler since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its

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suitability for the intended use. *In re Leshin*, 125 USPQ 416. Therefore, claims 47 and 48 are also rejected.

Regarding claims 7 and 49, which limits the thermosetting film to being “pre-cut to correspond to a shape of the transfer,” the claim is also obvious over the cited prior art. Said limitation reflects the method of making the flock transfer assembly. As such, said limitation is not necessarily given patentable weight at this time since the claims are examined on the structure of the final product claimed. It is believed that the final product of the prior art has the same structural features of the present invention. Therefore, claims 7 and 49 are also rejected.

Allowable Subject Matter

18. Claim 10 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

19. Said claim contains allowable subject matter in that the prior art of record does not teach or suggest a flock assembly having a *self-supporting* thermosetting film that is *not adhered to a substrate* as the flock adhesive for the flock assembly, wherein *there is no binder adhesive located intermediate* to said thermosetting film and said flock.

Conclusion


20. The art made of record and not relied upon is considered pertinent to applicant's disclosure.

21. Any inquiry concerning this communication or earlier communications from the

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examiner should be directed to Cheryl Juska whose telephone number is 571-272-1477. The examiner can normally be reached on Monday-Friday 10am-6pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached at 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

22. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


CHERYL A. JUSKA
PRIMARY EXAMINER

cj
February 13, 2007